



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,909	09/30/2003	Timothy Brian Nestor	030627/267422	9010

826 7590 08/03/2009

ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

EXAMINER
----------

NGUYEN, PHU HOANG

ART UNIT	PAPER NUMBER
----------	--------------

1791

MAIL DATE	DELIVERY MODE
-----------	---------------

08/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/674,909	<b>Applicant(s)</b> NESTOR ET AL.	
	<b>Examiner</b> PHU H. NGUYEN	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13-17, 19-25, 28-36 and 38-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2-9, 13-17, 19-25, 28-36 and 38-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Acknowledgement is made of Amendment received 4/16/2009. Claims 1, 17 and 33 are currently amended. Claims 3-9, 13-16, 19-25, 28-32, 34-36 and 38-52 are previously presented. Claims 2, 10-12, 18, 26-27, 37 and 53-57 are canceled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7-9, 13-16, 33, 35, 38-40, 42, 49-50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (U.S Patent No. 5325877).

Regarding claims 1, 4-5, 13-14 and 33, Young discloses a smokable material comprises a processed tobacco material comprising a mixture of an aqueous extracted tobacco pulp having at least a portion of the aqueous soluble portion removed therefrom, an aqueous extract applied to the aqueous extracted tobacco pulp, and an aerosol forming material (glycerin) applied to the aqueous-extracted tobacco pulp and in intimate contact therewith such that the aqueous extracted tobacco pulp is a substrate for the aerosol forming material, wherein the amount of aerosol forming material applied to the tobacco pulp exceeds the amount of aqueous extract applied to the tobacco pulp; wherein the smokable material comprises percent of tobacco without any non-tobacco filler overlapping with the claimed greater than 90 percent, based on the dry combined

Art Unit: 1791

weight of the tobacco and any non-tobacco filler, substitute, or extender material; percent tobacco and aerosol forming material, based on the dry weight of the smokable material overlapping with the claimed range of greater than about 85 percent; and percent aerosol forming material, based on the combined dry weight of the aerosol forming material and tobacco material overlapping with the claimed ranges of at least about 10 percent, 15 percent and 20 percent of claims 1, 13-14 respectively (Abstract and examples 4-5). Therefore, it would have been obvious to one having ordinary skill in the art to have selected the portion of the weight percentage ranges that corresponds to the claimed ranges. See *In re Malagari*, 184 USPQ 549 (CCPA 1974).

Young further discloses the smokable material can be used in a substantially cylindrical smokable rod shaped structure (it is obvious to one of ordinary skill in the art that the smokable rod has a lighting end and a mouth end) and an outer wrapping material such as paper) circumscribing the inner portion incorporating a smokable material, wherein the rod has a cylindrical shape and a longitudinally extending outer surface, the outer wrapping material providing the longitudinally extending outer surface, and wherein the lighting end is open to expose the inner portion such that the smokable material of the inner portion is positioned for lighting at the lighting end of the smokable rod (column 1, lines 5-15);

Regarding claim 3, Young discloses a filter (corresponding to the claimed "a mouth end piece") attached to the mouth end thereof.

Regarding claim 7, Young discloses essentially all the smokable tobacco material is composed of tobacco in cut filler form (column 2, line 63 to column 3, line 2).

Regarding claim 8, Young discloses essentially all the smokable tobacco material is composed of processed tobacco (column 1, line 49-59).

Regarding claim 9, Young discloses all or part of the tobacco material can be previously cased and/or top dressed (column 5, lines 50-53).

Regarding claim 15, Young discloses the aqueous tobacco extract is applied to the pulp in the form of a spray (column 8, lines 58-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to applied aerosol forming material to at least a portion of the smokable material in the form of a spray.

Regarding claim 16, since Young discloses in example 5 the glycerin (aerosol forming material is about 50 percent of the reconstituted sheet on a dry weight basis corresponding to the claimed that a portion of the smokable material includes a material composed primarily of aerosol forming material (column 11, lines 17-25).

Regarding claim 35, Young discloses the aerosol forming material in placed intimate contact with the processed tobacco during a cast sheet or paper type reconstituted tobacco process (example 5).

Regarding claim 38, Young discloses the processed tobacco material is a cast sheet material or a paper type reconstituted sheet material (example 1).

Regarding claims 39, 42, 49 and 52, Young discloses the process tobacco material is a paper type reconstituted sheet material comprising the aqueous extracted tobacco pulp and a mixture applied thereto, the mixture comprising aerosol forming material and aqueous extract extracted from the tobacco pulp.

Regarding claims 40 and 50, Young discloses the pectin release agent such as diammonium hydrogen orthophosphate (corresponding to the claimed "binder") can also be applied (example 4).

Claims 6, 17, 19-25, 28-32, 34, 36, 43-45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (U.S Patent No. 5325877) in view of Perfetti et al. (U.S Patent No. 4924888). Young discloses all the features of claims 6, 17, 19-25, 28-32, 34, 36, 43-45 and 47 as discussed above for claims 1-5, 7-9, 13-16, 35, 38-39, 40 and 42. However Young does not expressly disclose the inherent porosity of the outer wrapping material. Perfetti discloses the cigarette paper wrap is available commercially; in example 5, the paper has an inherent permeability of 15 CORESTA (column 11, line 23-31). The wrapping materials can be processed in order to have a relatively high net permeability values such as about 50 to about 250 CORESTA units (column 7, line 20-30). Therefore, one of ordinary skill in the art at the time the invention was made can obtain the commercially available cigarette paper wrap and process it to a desired permeability value.

Claims 41, 46 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (U.S Patent No. 5325877) in view of Perfetti et al. (U.S Patent No. 4924888) as applied to claims 40, 45 and 50 above and further in view of Jakob et al. (U.S Patent No. 5129408). The combination of Young and Perfetti suggests the cast sheet material comprising a binder. However, Young and Perfetti do not expressly disclose the binder is selected from a group consisting of citrus pectin, ammonium alginate, sodium alginate and guar gum. Jakob discloses the preferred binding agents

include the alginates, such as ammonium alginate, sodium alginate, propylene glycol alginate and potassium alginate can be employed; Jakob also discloses guar gum as another binding agents (column 7, line 53 to column 8, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the available binding agents as taught by Jakob.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-9, 13-17, 19-25, 28-36 and 38-52 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHU H. NGUYEN whose telephone number is (571)272-5931. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P.N 727/2009

***/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791***